

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3 November 2009 has been entered.

Correction of the Record

2. In the arguments filed on 3 November 2009 (p. 9), applicant alleged that the Board did not fully affirm the appealed rejections:

"The rejection of Claims 8-15, 19-20, 27-30 and 34 as being obvious under § 103(a) in view of Herz and Official Notice was not affirmed but was instead replaced by a new grounds for rejection over Herz under § 103(a)." (Lines 7-9 on page 9 of the amendment filed 3 November 2009, emphasis added)

That is not correct. The Board decided,

"The Examiner rejected claims 1-6, 16-18, 21-25, 31-33, 35, and 36 under 35 U.S.C. § 102(b) as being anticipated by Herz; and rejected claims 8-15, 19, 20, 27-30, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Herz.

We AFFIRM." (Lines 11-15 on p. 3 of the Board decision mailed 3 September 2009, emphasis added)

The Board (fully) affirmed the examiner and added its own grounds of rejection under 35 USC § 103 for the dependent claims 8-15, 19, 20, 27-30, and 34.

Interpretations

3. **Reception device** – A device operating on an **aggregated information system** that can receive message data contained on the plurality of **remote information systems**. (See para. [0021] and [0022] in the published application, US 20010056371A1).

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4. **Aggregated information system** – The applicant's special name for an electronic network having the properties of the invention. This is the broadest reasonable interpretation based on the disclosure (abstract and para. [0021] of the published application) that **reception device(s)** operate on an **aggregated information system** and Fig. 1, which shows **reception devices** (RD) operating on an exemplary network identified as the Internet (para. [0022] of the published application). The spec. (para. [0022] and [0023] of the published application) also discloses an **aggregated information system** (AIS) distinct from the RD's on said network, leaving it indefinite as to what the applicant means by **aggregated information system**. The spec. (para. [0014] of the published application) identifies Fig. 1 as "a system layer of the preferred embodiment of an aggregated information system of the present invention. But, "a system layer" is not defined in the spec. and is not a term of art (Google search of "define: system layer").
5. **Aggregating application** – One or more pieces of software that act together to aggregate (gather) information from **remote information systems** (para. [0023] of the published application).
6. **Remote information system** – A store of information on an electronic network. This is the broadest reasonable interpretation based on the disclosure (abstract and para. [0003] of the published application) that a "bulletin board" is a kind of **remote information system**.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3, 5, 6 and 8-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "An aggregated information system" (claim 1, line 1) is indefinite. See para. 4 above.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1, 3, 5, 6 and 8-20 are rejected under 35 U.S.C. 101 because the claimed invention, which is interpreted to be an abstract network (para. 4 above), does not fall within at least one of the four statutory categories of invention enumerated by 35 U.S.C. 101.

11. Claims 21, 22, 24, 25 and 27-36 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, _F.3d_, 2008 WL4757.

12. The instant claims fail to meet the machine-or transformation test because the claimed aggregation method, which reads on an algorithm, is so broad as to pre-empt all uses of a fundamental principle in the one field of information retrieval. The CAFC ruled in *Bilski*, "Pre-emption of all uses of a fundamental principle in all fields and pre-emption of all uses of the principle in only one field both indicate that the claim is not limited to a particular application of the principle. See *Diehr*, 450 U.S. at 193 n.14 ('A mathematical formula in the abstract is nonstatutory subject matter regardless of whether the patent is intended to cover all uses of the formula or only limited uses.')(emphasis added)."

13. Claims 1-3, 5, 6 and 8-20 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Although the claims on their face are directed to the "machine" or "manufacture" category of patent-eligible subject matter in Section 101, the claims are nonetheless nonstatutory based on the following two-part inquiry to determine

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whether the scope of the claimed invention encompasses one of the judicially-created exceptions:

For a claimed machine (or article of manufacture) involving a mathematical algorithm, the claimed "aggregation application" reading on a mathematical algorithm,

(1) Is the claim limited to a tangible practical application, in which the mathematical algorithm is applied, that results in a real-world use (e.g., "not a mere field-of-use label having no significance")?

(2) Is the claim limited so as to not encompass substantially all practical applications of the mathematical algorithm either "in all fields" of use of the algorithm or even in "only one field?"

If the machine (or article of manufacture) claim fails either prong of the two-part inquiry, then the claim is not directed to patent eligible subject matter. (*Ex Parte Gutta*, BPAI 2009, Precedential)

In this case the claims encompass substantially all practical applications of the aggregation application mathematical algorithm in the one field of information retrieval.

Claim Rejections - 35 USC § 102 and 35 USC § 103

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 1-3, 5, 6, 8-22, 24, 25 and 27-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as unpatentable over Herz et al. (US005754938A, hereafter "Herz").

17. Herz teaches (independent claims 1 and 21) a system and method for aggregating information, the system comprising:

an aggregating application (*Virtual Community Service*, col. 73 lines 36-41) in communication with a plurality of remote information systems (*thousands of Internet bulletin boards*, col. 73 lines 11-17), said aggregating application executing in one or more computer processors (*servers S1 to S5*, col. 30 lines 26-31) and configured to:

creating a new virtual community V (col. 76 lines 7-10), which reads on, aggregate original message data and response message data from different ones of said plurality of remote information systems to create aggregated message and response data relating to a topic (*common interests* of groups of users, col. 74 lines 42-43);

provide said aggregated message and response data (col. 76 line 66 to col. 77 line 4) to a plurality of reception devices (*individual user's computer systems*, col. 3 lines 26-31);

receive at the aggregating application, additional message data (*new messages*, col. 76 lines 62-65) from at least one of said plurality of reception devices, wherein said additional message data from said reception device comprises at least one of additional response message data (col. 74 lines 36-38) or additional original message data;

aggregate said additional message data with said aggregated message and response message data (col. 76 lines 62-65); and

determine whether at least one of said remote information systems contains information relating to a topic of said additional message data (*new messages whose target profiles are similar to the community's cluster profile*, col. 76 lines 62-65) and

provide the additional message data to the at least one of said remote information systems based on the determination that said at least one of said plurality of remote information systems contains information relating to a topic of said additional message data (col. 76 line 66 to col. 77 line 4).

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18. Alternatively, the claimed distinction between “original” and “response” message data is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A). Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.
19. Alternatively, because the aggregation would be worthless without both original and response message data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Herz that both original and response message data be aggregated.
20. Herz also teaches at the citations given above claims 3 and 22, claims 5, 6, 24 and 25, and claims 17, 18, 32, and 33.
21. Herz also teaches: claim 2 (col. 56 lines 28-30 and Fig. 2); claims 16 and 31 (col. 73 lines 29-32); claims 17-20 and 32-35 (col. 17 lines 15-33); and 36 (col. 18 lines 13-23 and col. 55 lines 38-60).
22. Claims 8-15 and 27-30 add only non-functional descriptive material (printed matter) and, accordingly, were not given patentable weight (MPEP § 2106.01 and 706.03(a)A and page 8-9 of the Board decision mailed 3 September 2009). .

Response to Arguments

24. Applicant's arguments filed with an amendment on 3 November 2009 have been fully considered in the revised rejection.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
26. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633. The fax phone number for all *formal* fax communications is 571-273-8300.

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27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16 January 2010

/Donald L. Champagne/
Primary Examiner, Art Unit 3688